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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,716	12/18/2000	George W. Turner	00-332	5066

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP  
300 S. WACKER DRIVE  
32ND FLOOR  
CHICAGO, IL 60606

EXAMINER

ELAHEE, MD S

ART UNIT

PAPER NUMBER

2645

DATE MAILED: 06/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/739,716

Applicant(s)

TURNER ET AL.

Examiner

Md S. Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 14-29 and 45-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-13, 30-44, 49 and 50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-29 and 45-48 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claim 25 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 14 of U.S. Patent No. 6,718,030. Because claims in the co-pending application are broader than the ones in patent, *In re Van Ornum and Stang*, 214 USPQT61, broad claims in the co-pending application are rejected as obvious double patenting over previously patented narrow claims. For example, claim 25 of the co-pending application is the same as claim 14 of the patent except that customer addresses and network addresses are alterable based on locations of the devices within the private network.

### *Response to Amendment*

3. This action is responsive to an amendment filed on 12/20/04. Claims 14-29 and 45-48 are pending. Claims 1-13, 30-44, 49 and 50 have been withdrawn.

### *Response to Arguments*

4. Applicant's arguments mailed on 14-24 have been fully considered but are moot in view of the new ground(s) of rejection.

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Applicant's arguments with respect to claims 45-48 have been fully considered but they are not persuasive.

Regarding claim 45, the Applicant argues on page 26, lines 16-18 that Kung teaches a passage that does not refer to any bi-directional transfer of a token "back from the call agent in the originating gateway to the proxy server at the terminating agent, as is claimed by Applicants". The examiner disagrees with this argument. Because, the applicant didn't claim transfer of a token back from the call agent in the originating gateway to the proxy server at the terminating agent. Thus the rejection of the claim in view of Kung remain.

#### *Specification*

5. The disclosure is objected to because of the following informalities: the Serial No. '09/636,191' used in page 10, line 7 appears to be '09/636,192'.

Appropriate correction is required.

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 14-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al. (U.S. Patent No. 6,252,952) and in view of Pepper et al. (U.S. Patent No. 5,930,700).

Regarding claim 14, Kung teaches receiving a call request at one of a residential and voice gateway from at least one of a Public Switched Telephone Network and a plurality of

private users (fig.1, fig.5; col.25, lines 53-67; 'voice gateway' reads on the claim 'trunk gateway').

Kung further teaches determining the physical location of the called party (fig.5; col.26, lines 27-40, 65-67, col.27, lines 1-17).

Kung fails to teach "evaluating a set of privileges associated with the calling and called party, and negotiating a set of terminating options supplied by the called party, to establish permission to set up the call and to identify a precise terminating networking address from amongst a plurality of such addresses". Pepper teaches evaluating a set of priorities [i.e., privileges] associated with the caller [i.e., calling] and subscriber [i.e., called party], and negotiating a set of terminating options supplied by the subscriber, to establish permission to set up the call and to identify a precise terminating networking address from amongst a plurality of such addresses (abstract; col.10, line 60-col.11, line 17, col.12, lines 29-33). (Note: Voice mail number and telephone numbers are network addresses) Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kung to allow evaluating a set of privileges associated with the calling and called party, and negotiating a set of terminating options supplied by the called party, to establish permission to set up the call and to identify a precise terminating networking address from amongst a plurality of such addresses as taught by Pepper. The motivation for the modification is to have doing so in order to handle the call between the calling and the called party based on the priority.

Kung further teaches determining a least cost route to set up the call (col.8, lines 28-34, col.10, lines 26-30; 'least cost route' reads on the claim 'optimum route').

Kung further teaches establishing the least cost route and matching the call request with a call at a network termination point of the called party (col.8, lines 28-34, col.10, lines 26-30; 'least cost route' reads on the claim 'optimum route').

Regarding claim 15, Kung teaches translating between a network address associated with the call request in a system management server and a customer address for calls between the plurality of private users (col.7, lines 26-62, col.8, lines 15-27, col.10, lines 54-67, col.11, lines 1-6, col.12, lines 1-11; 'system management server' reads on the claim 'directory server').

Kung further teaches translating between the network address and an Internet Protocol address in a domain name service server (col.7, lines 26-62, col.10, lines 54-67, col.11, lines 1-6, col.12, lines 1-11; 'domain name service server' reads on the claim 'domain name server').

Regarding claim 16, Kung teaches generating a network address from a user name (col.7, lines 26-62).

Regarding claim 17, Kung teaches translating a network address includes the system management server determining if the call request associated with one of the Public Switched Telephone Network and the plurality of private users (col.7, lines 26-62, col.8, lines 15-27, col.10, lines 54-67, col.11, lines 1-6, col.12, lines 1-11; 'system management server' reads on the claim 'directory server').

Regarding claim 18, Kung teaches passing the call request from the residential gateway to a call manager (fig.1, fig.5; col.25, lines 53-67; 'call manager' reads on the claim 'call agent').

Regarding claim 19, Kung teaches determining if the call request is associated with one of the Public Switched Telephone Network and the plurality of private users further comprises

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determining if the dialed digits are preceded by an escape prefix (fig.1, fig.5; col.25, lines 53-67, col.26, lines 1-41).

Regarding claim 20, Kung teaches that evaluating a set of priorities comprises evaluating at least one of routing preferences, bandwidth reservation, and overriding a busy status of the called party (fig.5; col.6, lines 19-33, col.15, lines 38-67, col.16, lines 1-5, col.34, lines 52-55; 'priorities' reads on the claim 'privileges').

Regarding claim 21, Kung teaches that a computer readable medium having stored therein a set of instructions for causing a processing unit to execute the steps of the method (col.9, lines 39-67, col.10, lines 1-9).

Regarding claim 22, Kung teaches evaluating an external similar set of priorities it is determined that the called party is in an external telephone network system, launching simultaneous person locator queries to the system management servers of the external telephone network systems (fig.1, fig.5; col.6, lines 19-33, col.8, lines 15-27, col.26, lines 27-40; 'priorities' reads on the claim 'privileges' and 'system management servers' reads on the claim 'directory servers').

Regarding claim 23, Kung teaches that the system management server further comprises a suite of user specific features such as speed call, selective call forwarding, time-of-day routing, together with associated lists of numbers (col.8, lines 15-27; 'system management server' reads on the claim 'directory server').

Regarding claim 24, Kung teaches recognizing and providing a network address to a roaming user using a local service management system (col.10, lines 54-67, col.11, lines 1-6, col.23, lines 13-39; 'local service management system' reads on the claim 'portability server').

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8. Claims 45-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al. (U.S. Patent No. 6,252,952) and in view of Thomas (U.S. Patent No. 6,751,652).

Regarding claim 45, Kung teaches returning a token from a server at a terminating gateway to a call manager in an originating gateway (fig.1, fig.2; col.5, lines 38-42, col.35, lines 8-25; 'server' reads on the claim 'proxy server' and 'call manager' reads on the claim 'call agent').

Kung further teaches inherently saving the token and all pertinent call data for the subsequent Public Switch Telephone Network call at the server (fig.1, fig.2; col.35, lines 8-25; 'server' reads on the claim 'proxy server').

Kung further teaches returning the token to the terminating gateway from the originating gateway, in the call, when a Public Switched Telephone Network voice path is eventually established (fig.1, fig.2; col.5, lines 38-42, col.35, lines 8-25).

Kung fails to teach "searching a database of calls in progress at the terminating end, obtained from the proxy server, for a match with the token returned". Thomas teaches making a query (i.e., searching a database) of calls in progress at the terminating end, obtained from the proxy server, for a match with the token returned (col.5, line 61- col.6, line 15). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kung to allow searching a database of calls in progress at the terminating end, obtained from the proxy server, for a match with the token returned as taught by Thomas. The motivation for the modification is to have doing so in order to check the valid token.

Kung further teaches associating the at least one of Voice and Video over Internet Protocol signaling component of the hybrid call with the Public Switched Telephone Network



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component at both the originating gateway and terminating gateway of the call (col.6, lines 19-33).

Regarding claim 46, Kung teaches the token comprising of a long integer which is incremented with each subsequent request for a new token (col.35, lines 8-25).

Regarding claim 47, Kung teaches establishing a hybrid environment where a voice path for calls can be established via a Public Switched Telephone Network (fig.1, fig.2).

Kung further teaches determining at the time of setting up a Public Switched Telephone Network call that the destination for the call is within the Virtual Private Network, but at a different gateway (fig.1, fig.2; col.16, lines 6-22).

Kung further teaches populating the available characters of the Signaling System 7 parameter in the Initial Address Message with any proprietary data that needs to be sent to the other end, if the destination is within the Virtual Private Network, as determined by a target directory number (fig.1, fig.2; col.16, lines 6-22).

Kung further teaches extracting data from the available characters at the destination, if the source is within the Virtual Private Network, as determined by the calling line identity (col.16, lines 6-22, col.20, lines 10-55).

Regarding claim 48, Kung teaches populating the parameter with calling name information in accordance with the conventional Public Switched Telephone Network if the destination is external to the Virtual Private Network, as determined by the target directory number and wherein the parameter is a generic name parameter (fig.1, fig.2; col.16, lines 6-22, col.20, lines 10-55, col.24, lines 30-55).

*Allowable Subject Matter*

9. Claims 25-29 will be allowed if the double patenting rejection is overcome.

*Conclusion*

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Leleu (U.S. Patent No. 6,088,687) teach Billing procedure and system for data transmission networks and Emery et al. (U.S. Patent No. 6,519,242) teach Apparatus and method of PSTN based network roaming and SCP based subscriber management for internet telephony systems.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S. Elahee whose telephone number is (571) 272-7536. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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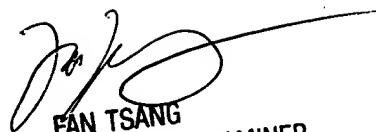
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M.E.

MD SHAFIUL ALAM ELAHEE

May 25, 2005



FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600